Supreme Court, U.S.
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No. 99-

IN THE

Supreme Court of the United States

ABBOTT LABORATORIES,

Petitioner,

v.

MYLAN PHARMACEUTICALS, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

The Court of Appeals for the Federal Circuit summarily affirmed the District Court's determination that a United States Patent issued to petitioner Abbott Laboratories was invalid. The sole ground for the District Court's ruling, and the sole ground for the Court of Appeals' ruling, was collateral estoppel, for the same patent had been held invalid in a matter entitled *Abbott Laboratories v. Geneva Pharmaceuticals, Inc.*, 1998 WESTLAW 566884 (N.D. Ill. Sept. 1, 1998), *aff'd*, 182 F.3d 1315 (Fed. Cir. 1999) (hereinafter "*Geneva*").

Abbott Laboratories' petition for a writ of certiorari in the *Geneva* matter is presently pending before this Court (case no. 99-753). The issue presented by this petition, therefore, is: Should the Court accept review of this matter in order to preserve its ability to reverse the judgment if it reverses the judgment in the *Geneva* matter?

PARTIES TO THE PROCEEDING

The petitioner, Abbott Laboratories, was the plaintiff-appellant below. The respondent, Mylan Pharmaceuticals, Inc., was the defendant-appellee below. There are no other parties to this litigation. Abbott Laboratories' petition for a writ of certiorari is presently pending in a related case entitled *Abbott Laboratories v. Geneva Pharmaceuticals, Novopharm, Ltd. and Invamed, Inc.*, Supreme Court Case No. 99-753.

Petitioner Abbott Laboratories has no parent corporation, and no publicly held company owns 10% or more of its stock.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is unreported and appears in Appendix A. The district court's unreported order granting summary judgment appears in Appendix B.

STATEMENT OF JURISDICTION

The opinion and order of the Court of Appeals was entered on October 4, 1999. The Court of Appeals' jurisdiction was based upon 28 U.S.C. § 1295(a)(1). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

35 U.S.C. § 102 provides in relevant part:

> A person shall be entitled to a patent unless —
>
> * * *
>
> (b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . .

STATEMENT OF THE CASE

After scientists working at Abbott Laboratories (hereinafter "Abbott") discovered terazosin hydrochloride, a chemical compound useful for treating high blood pressure and enlargement of the prostate, Abbott was awarded a United States Patent covering that compound. Abbott scientists subsequently discovered that terazosin hydrochloride exists in different crystal forms, or polymorphs. Different polymorphs of a compound may vary in characteristics such

as density, hardness or solubility, and they have been found to be unique and patentable inventions. *See Zenith Laboratories v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1419-20 (Fed. Cir.), *cert. denied*, 513 U.S. 995 (1994).

In the early 1990s, Abbott discovered a previously unknown polymorph of terazosin hydrochloride known as "Form IV." Abbott received United States Patent 5,504,207 ("the '207 patent") covering the Form IV polymorph on April 2, 1996. Abbott subsequently brought several suits against companies that had announced an intention to market a pharmaceutical product containing Form IV terazosin hydrochloride.

In one such case, *Abbott Laboratories v. Geneva Pharmaceuticals, Inc.*, nos. 96 C 3331, 96 C 5868, and 97 C 7587 (N.D. Ill. Aug. 28, 1998), the district court granted the defendants' motion for summary judgment and held Abbott's 207 patent to be invalid under section 102(b) of the Patent Act. The district court found that as a result of several transactions involving third parties, Form IV terazosin hydrochloride had been put on sale more than one year before Abbott filed its application for a patent on that compound. The court rejected Abbott's contention that section 102(b) was inapplicable where there was no evidence that any of the buyers, sellers or manufacturers of the chemical compound in question was aware that that compound consisted of a new and useful form of terazosin hydrochloride.

In an opinion and order entered on July 1, 1999, the Court of Appeals for the Federal Circuit affirmed the district court's entry of summary judgment. *See Abbott Laboratories v. Geneva Pharmaceuticals, Inc.*, 182 F.3d 1315 (Fed. Cir. 1999) (hereinafter "*Geneva*"). The Court of Appeals held that it was "irrelevant" under section 102(b) that "the parties to the sales transactions did not know they were dealing in Form IV at the time of the sales. . . ." *Id.* at 1318.

On October 29, 1999, Abbott Laboratories filed a petition for writ of certiorari in the *Geneva* matter. The petition contends that summary reversal or review by writ of certiorari is appropriate because the Court of Appeals' holding that the "on-sale bar" of section 102(b) was triggered by the *unknowing* manufacture and sale of a new chemical compound is in direct conflict with *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 119 S. Ct. 304 (1998). This Court held in *Pfaff* that the process of conception must be complete before the on-sale bar can arise. Abbott Laboratories' petition is presently pending (case no. 99-753).

In the instant case, the district court granted defendant's motion for summary judgment on March 4, 1999 and held Abbott's '207 patent to be invalid. The court's order was based entirely upon the collateral estoppel effect of the district court's judgment in the *Geneva* matter. Appendix B at 6a-7a. On October 4, 1999, the Court of Appeals for the Federal Circuit summarily affirmed the district court's entry of judgment. Appendix A at 2a. This petition followed.

REASONS FOR GRANTING THE WRIT

I.

IF THIS COURT GRANTS CERTIORARI IN THE *GENEVA* CASE, IT SHOULD GRANT CERTIORARI HERE IN ORDER TO ENSURE CONSISTENT RESULTS AND TO AVOID INJUSTICE.

The sole basis for the lower courts' holdings in this case was the collateral estoppel effect of the prior judicial decisions in the *Geneva* matter. If this Court grants Abbott's petition for writ of certiorari in *Geneva*, it should also grant review here to ensure that the judgment of invalidity in this case does not survive the reversal of the related judgment upon which it is based. Considerations of fairness and judicial

consistency strongly favor a grant of review under these circumstances. *See generally* Wright, Miller & Cooper, Federal Practice and Procedure: Jurisdiction, § 4433 (1981 ed.), at p. 313 (discussing the need to "achieve full protection against the grotesque result of perpetuating a judgment that rests on nothing more than a subsequently reversed judgment. . ." and recommending "a protective appeal in the second action that is held open pending determination of the appeal in the first action. . . .").[1]

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1. If review is not granted here, Abbott Laboratories could, in the event of a reversal by this Court of the judgment in *Geneva*, file a motion in the Court of Appeals to recall its mandate in this matter and to remand the matter to the district court for further proceedings. *See, e.g., United States v. Tolliver*, 116 F.3d 120, 123-34 (5th Cir. 1997) (granting motion to recall mandate where Supreme Court had reversed convictions of moving party's co-defendants). In order to avoid the need for these further proceedings, however, the Court should grant the relief sought by this writ.

CONCLUSION

For the foregoing reasons, this writ should be granted.

Respectfully submitted,

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